

REMARKS

In order to promote administrative efficiency and better communication, the Examiner is invited to make suggestions at any time during the proceedings, via phone, fax or e-mail, whenever such suggestions are within the Examiner's discretion as an aid to placing the claims in order for allowance in a timely manner.

Priority Claim:

Applicant wishes to bring to the attention of the office the fact that priority was duly claimed in the Declaration to US provisional application Serial No. 60/509,706 filed on October 8, 2003. Applicant has amended the Cross reference section of the specification to eliminate any ambiguity on this point.

Claim Rejections:

35 USC §103

The Examiner rejected claims 1-14 and 16 under 35 U.S.C. §103(a) as being unpatentable over Slocum in view of Steiner. Applicant has amended the claims to make clear that at least one novel and unobvious aspect of the invention is that the invention has overlapping holes defining multifaceted surfaces, and that a further novel and patentable aspect of the invention is that two sets of such overlapping holes having multifaceted surfaces are located so as to lie on opposite sides of an osteotomy site. Essentially, the wording of claim 1 has been amended to make this more clear while introducing no further limitations into the claims.

Applicant wishes to point out that although Steiner states that "non-combination holes require surgeons to compromise between two types which would be less ideal", Steiner does not teach, suggest or imply the combination (i.e., overlapping) of two overlapping holes having multifaceted surfaces. Rather, what is referred to here is what was in the *prior art*, namely, (1) separate, non-overlapping, threaded holes, (2) separate non-overlapping, non-threaded holes, and (3) overlapping non-threaded holes. True, one of the most important innovations in the invention, namely, having two overlapping holes having multifaceted surfaces, does not require

knowledge of rocket science to invent, but this is not required. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) is particularly instructive on this point. In *Gordon*, the application claimed a blood filter with the inlet and outlet at the bottom of the device. The prior art disclosed the inlet and outlet at the top of the device. *Id.* at 1126-27. The Federal Circuit reversed the Office's finding of obviousness and held that regardless of how simple it may have been to modify the prior art, there was no suggestion in the prior art reference to make such a modification. The Federal Circuit emphasized that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. *Id.* at 1127. Further, «Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. As the Examiner is aware, it is impermissible to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.»¹ *Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.*² According to the Federal Circuit, "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation . . ."³ It is respectfully submitted therefore that to persist in the rejection would require that the Examiner engage in impermissible hindsight reconstruction of the invention.

Consequently, it is believed that the independent claims of the application define a patentable invention. Further, claims dependent on the patentable independent claims are

¹ *In re Gorman*, No. 90-1362, slip op. at 7 (Fed. Cir. May 13, 1991) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and affirming the Board's finding that a molded candy on a stick was obvious); *In re Fritch*, No. 91-1318, slip op. at 12 (Fed. Cir. Aug. 11, 1992) (reversing the Board's rejection of landscape edging as obvious).

² *In re Vaeck*, No. 91-1120, slip op. at 10 (Fed. Cir. Oct. 21, 1991) (reversing the PTO Board's affirmance of the examiner's rejection of certain claims under § 103, and citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988)).

³ *In re Dembiczak*, 50 USPQ2d ____ (Fed. Cir. 1999), Case No. 98-1498 (Serial No. 08/427,732) (*emphasis added*).

limited thereby, and thus also define a patentable invention. Acknowledgement of this fact is respectfully requested.

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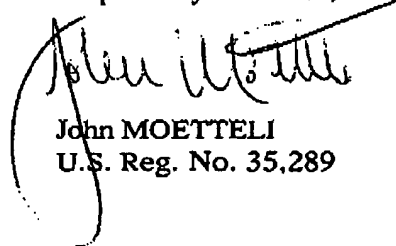
Conclusion

Applicant has made a diligent effort to advance the prosecution of this application by amending claims, and by pointing out herein with particularity how the claims now presented are patentably distinct from the prior art of record. Therefore, Applicant respectfully submits that the claims, as amended, are now in condition for allowance. No new matter has been entered by this amendment. Any limitations to the claims are made solely for the purpose of expediting the prosecution of the application and, unless otherwise expressly stated, are not made to narrow, vis-à-vis the prior art, the scope of protection which any subsequently issuing patent might afford. Again, if the Examiner has further questions, he is invited to contact the undersigned at phone 011-4171-230-1000, fax at 011-4171-230-1001 (Switzerland is 6 hours ahead of Eastern Std Time), or e-mail at moetteli@patentinfo.net.

Applicant petitions the Commissioner for an Extension of Time under 37 CFR §1.136 for a period of ONE month and the Undersigned authorizes the Commissioner to charge any fee or credit any overpayment of any fee under 37 CFR §1.16 and §1.17 which may be required in this application to the deposit account of MOETTELI & ASSOCIES SARL, no. 50-2621.

Date : June 5, 2006

Respectfully submitted,


John MOETTELI
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